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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/074,012	05/05/98	YOSHIDA	S 0694-121

IM31/0802

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EXAMINER	
PIANALTO,B	

ART UNIT	PAPER NUMBER
1762	20

DATE MAILED: 08/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/074,012	Applicant(s) YOSHIDA ET AL.	
	Examiner Bernard D Pianalto	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 July 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *10-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 10, 11,15 and 17-21 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hartman. The Hartman reference discloses in col.1, lines 9-20, col.4, lines 5-59, col.5, lines 1-10 and col.7, lines 45-68 a tape comprising a substrate having a conductive plate layer and a layer comprising soft magnetic particles and alumina particles dispersed in an amide polymer binder on the conductive layer. A heat sink can be attached to the tape. The arrays of Hartman encompass the integrated circuits and circuit boards claimed since arrays are integrated circuits arranged on a circuit board and their electrical terminal are connected with the Hartman tape. It is the examiner's opinion that applicants' article is at the very least an obvious variation of the Hartman article. The Hartman article would inherently suppress electromagnetic interference since the Hartman article and the claimed article are the same. In addition, the presently claimed property of electromagnetic interference suppression would obviously have been present once the

Hartman product is provided. Note In re Best, 195 USPQ at 433, footnote 4 (CCPA 1997) as to the providing of this rejection made above under 35 USC 102.

Claims 10 and 11 are further rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either Goto et al or Horie et al. The Goto et al and Horie et al references both disclose articles comprising soft magnetic particles and alumina particles dispersed in polymer binders. See col.3, lines 42-65 and col.4, lines 1-20 of Horie et al and col.9, lines 20-54 of Goto et al. It is the examiner's opinion that applicants' article is at the very least an obvious variation of the Goto et al or Horie et al article. The articles of Goto et and Horie et al would inherently suppress electromagnetic interference since the claimed articles and the references are the same. In addition, the presently claimed property of electromagnetic interference suppression would obviously have been present once the Goto et al and Horie et al products are provided. Note In re Best, 195 USPQ at 433, footnote 4 (CCPA 1997) as to the providing of this rejection made above under 35 USC 102.

Claims 12,13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman, Horie et al or Goto et al for the same reasons as urged in the above paragraphs in view of Takahashi et al. The primary references fail in anticipation of Claims 12,13 and 14 in that they do not disclose an article in sheet form having a polyamide binder having the claimed glass transition temperature. The Takahashi et al reference discloses in col.6, lines 5-56 and col.8, lines 65-68 a magnetic device comprising soft magnetic material and alumina dispersed in a polyamide resin binder having a glass transition temperature within the claimed range. It is the examiner's

opinion that it would have been obvious for one of ordinary skill in this art at the time the invention was made to substitute the binder of Takahashi et al for the binder of Hartman since the secondary reference discloses that high electromagnetic conversion characteristics result. It is also the examiner's opinion the sheet shape claimed does not distinguish over the reference articles since changes of size, degree, shape, proportion and sequence of adding ingredients are considered obvious modifications. See In re Rose, 105 USPQ 237; In re Aller et al 105 USPQ 233; In re Daily et al 149 USPQ 47; In re Reese 129 USPQ 402 and In re Gibson 5 USPQ 230.

Claims 10-13 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Takahashi et al. for the same reasons as urged in the above paragraph. The suppression of electromagnetic radiation interference would be inherent in the Takahashi et al article since the reference article and the claimed article are the same. In addition, the presently claimed property of electromagnetic interference suppression would obviously have been present once the Takahashi et al product is provided. Note In re Best, 195 USPQ at 433, footnote 4 (CCPA 1997) as to the providing of this rejection made above under 35 USC 102.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman for the same reasons as urged above taken with either Ogawa et al or Takahashi et al. Each of these references discloses in the abstract a magnetic device comprising a backing having two magnetic layers. It is the examiners opinion that it would have been obvious for one of ordinary skill in this art at the time the invention was made to

substitute a two layer system for the one layer system of Hartman since both references disclose that high electromagnetic conversation characteristics result.

The restriction of 3-19-01 is still considered proper but modified to include the claims of group II with the claims of Group I.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard D Pianalto whose telephone number is 703 308 2332. The examiner can normally be reached on Mo - Wed 5:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on 703 308 2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305 3599 for regular communications and 703 305 3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 306 5665.

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July 31, 2001

Bernard Pianalto

BERNARD PIANALTO
PRIMARY EXAMINER